

**REMARKS****Amended Claims**

Claims 1-10 and 12-20 are amended herein.

**Claim Rejections Under 35 U.S.C. § 102**

Claims 1-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by McIntyre (U.S. Publication No. 2003/0063305). Applicant respectfully traverses this rejection. Applicant reserves the right to swear behind the reference McIntyre et al., but submits that claims 1-20 are allowable for the following reasons.

Applicant has amended the claims in the interests of furthering prosecution. Specifically, Applicant has amended independent claims 1, 6, 8 and 15 to specify that a first printer is being upgraded from a second printer having a desired configuration, and not a network location, when the first printer receives an upgrade command from a management facility. Claims 1, 6, and 8 also specify that the upgrade command is received from a third printer that has an internal management facility expressed by an embedded webserver.

Applicant respectfully maintains, as detailed herein, that the Office Action mailed on January 9, 2008 utilizes two separate embodiments of McIntyre that are mutually exclusive picks the elements that suit the desired rejection and arranges them in same manner as required by the rejected claims, even though the embodiments disclose arrangements of the elements that are mutually exclusive. The first embodiment cites a central command is given by the printer control program (the management facility) to restore the configuration on the selected printers, while in the second embodiment manual intervention by the administrator is required to separately update the configuration of each printer via a control panel of the printer and it's resident internal printer control program. As such, Applicant maintains that the elements of the separate embodiments cannot be combined as they disclose mutually exclusive arrangements of the elements.

Applicant also maintains that McIntyre does not teach or disclose a first printer that requests a device configuration to upgrade the first printer from a second printer across a

network upon receiving an external upgrade command given by a management facility resident on a third printer. As such, Applicant respectfully maintains that the first embodiment of McIntyre fails to teach or disclose all elements of claims 1-20, as amended.

In the Final Office Action mailed on January 9, 2008, the Examiner stated:

In response to applicant's statement that McIntyre discloses two separate embodiments, MPEP 2136.02 explains that a 35 U.S.C. 102(e) rejection may rely on any part of the patent or application publication disclosure. Under 35 U.S.C. 102(e), the entire disclosure of a U.S. patent, a U.S. patent application publication, or an international application publication having an earlier effective U.S. filing date (which will include certain international filing dates) can be relied on to reject the claims. *Sun Studs, Inc. v. ATA Equip. Leasing, Inc.*, 872 F.2d 978, 983, 10 USPQ2d 1338, 1342 (Fed. Cir. 1989). See MPEP § 706.02(a).

As claimed, McIntyre also teaches an external management facility sending across a network to a device (i.e. first device) an upgrade command and a network address associated with the desired configuration (i.e. second device). The first device then sends a request for the desired configuration to the second device. McIntyre's second embodiment teaches a printer control program remote to printer 220 sending an update command across a network to printer 220. The configuration settings are stored in storage media 240, which may be located in printer 221. Printer 220 accesses the configuration settings in storage media 240. See paragraphs 33-35.

*See*, Final Office Action mailed on January 9, 2008, Pages 2-3, Item 3.

Applicant respectfully disagrees. Applicant however has amended the claims in the interests of furthering prosecution. Specifically, Applicant has amended independent claims 1, 6, 8 and 15 to specify that a first printer is being upgraded from a second printer having a desired configuration when the first printer receives an upgrade command from a third printer that has an internal management facility expressed by an embedded webserver.

Applicant respectfully continues to maintain that the method and apparatus of McIntyre outlined in Paragraphs 33-35, does not teach the elements of claims 1, 6, 8 and 15, as amended. Specifically, the Office Action contains elements pulled from separate and different embodiments of McIntyre. Applicant understands that, as stated in MPEP §2136.02, the Examiner is allowed to utilize the whole disclosure of a cited reference. However, Applicant respectfully maintains that, contrary to the Examiner's assertion, combining elements of differing, mutually exclusive, embodiments from a given reference is not permissible for a rejection under 35 U.S.C. § 102(e). *See*, MPEP §2131.

Applicant respectfully maintains that in an anticipation rejection over a prior art reference under 35 U.S.C. § 102 it is error to combine mutually exclusive embodiments from the reference, picking only those elements that suit the desired rejection and arranging them in same manner as required by the rejected claims even though the embodiments disclose mutually exclusive arrangements of the elements. Applicant maintains that a proper rejection for anticipation under 35 U.S.C. § 102 requires that all elements of the rejected claims need to be found in the cited reference, but also that they need to be arranged in same manner as required by the rejected claims. As such, Applicant respectfully maintains that the Office Action's rejection does not take into account the proper legal standard for a rejection under 35 U.S.C. § 102(e), namely that all the elements of the claim must be found arranged in the same manner without the need for picking and choosing among multiple embodiments with mutually exclusive arrangements. *See*, MPEP §2131, which states in pertinent part, "the elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)." *See also*, *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972).

In view of the above, Applicant specifically continues to contend that the Office Action impermissibly combined the external management facility 150 sending across a network to a printer an upgrade command and downloading the desired configuration of McIntyre's first disclosed embodiment of Figure 1 and Paragraphs [0027]-[0029] with the local printer control program of the printer 220 of the second embodiment of McIntyre disclosed in Figure 2 and Paragraphs [0032]-[0035] which discloses the local printer control program, accessed on the printer through the printer control panel, storing configuration settings from the printer 220 in storage media 240 for later restoration. The second embodiment of McIntyre also discloses that

the storage media 240 of the embodiment may either be located in printer 220 or on a network location allowing other printers 220 to access the configuration settings in storage media 240 when directed by their own local control programs.

Applicant respectfully continues to maintain that the elements recited by the Examiner in the second paragraph of the Final Office Action section of Item 3 quoted above in rejecting claims 1-20 of the Present Application come from differing embodiments and are being impermissibly combined in the rejection to create the arrangement specified by the pending claims 1-20.

Applicant therefore continues to maintain, as stated previously, that McIntyre discloses in the first cited embodiment, shown in Figure 1, a system has networked printers 120 operating under the control of an external printer control program 150 resident on a computer, where any locally customized printer configurations can be saved by the external management program and then downloaded and restored on the printers 120 after a firmware upgrade, either manually or automatically. *See*, McIntyre, Figure 1 and Paragraphs [0027]-[0029]. Applicant also specifically notes that, as stated in Paragraph [0029] of McIntyre, in this first embodiment, the configurations are only restored to their original printers 120. In addition, Applicant specifically notes that Paragraph [0029] of McIntyre only discloses that these configurations are restored by being downloaded with the update command from the remote printer control program, not by referencing a network location of another printer 120, or network location of another printer's stored configuration, and commanding the designated printer 120 to update itself directly from the other printer or network location by accessing it and pulling the configuration data from the source.

Applicant therefore respectfully submits that the first embodiment disclosed in McIntyre Figure 1 and Paragraphs [0027]-[0029] fails to teach or disclose a first printer that requests a device configuration to upgrade the first printer from a second printer across a network upon receiving an external upgrade command given by a management facility resident on a third printer. Applicant also respectfully submits that the first embodiment of McIntyre also fails to teach or disclose a method of upgrading a first printer, comprising receiving across a network an external upgrade command from a management facility and a network location associated with second printer having a desired device configuration for the printer, and retrieving the desired device configuration from the network location of the second printer, where the management

facility is resident on a third printer. As such, Applicant respectfully maintains that the first embodiment of McIntyre fails to teach or disclose all elements of claims 1-20, as amended.

In the second cited embodiment of McIntyre, shown in Figure 2 and described in Paragraphs [0032]-[0035] of McIntyre, the printer control program 250 is only disclosed as being resident on the printers 220, 221 and in operation only saves the local configuration of the printer it is resident on to a storage media 240. The local printer control program resident on the specific printer is then used to select and restore configuration settings from the storage media 240 after firmware upgrade. This storage media 240 can also be networked and be commonly accessible by other printers 220 on the network. However, in this embodiment, McIntyre only discloses in Paragraph [0034] that, once the configuration of a specific printer is saved to the commonly accessible storage media 240, the user can then only load it on to another printer on the network by physically accessing the internal control program 250 resident on the selected printer 220 via the printer's external control panel to download the saved configuration to that printer 220. *See*, McIntyre, Figure 2 and Paragraphs [0032]-[0035].

Applicant therefore continues to respectfully submit that the second embodiment disclosed in McIntyre Figure 2 and Paragraphs [0032]-[0035] fails to teach or disclose a first printer that requests a device configuration to upgrade the first printer from a second printer across a network upon receiving an external upgrade command given by a management facility resident on a third printer. Applicant also respectfully submits that the second embodiment of McIntyre also fails to teach or disclose a method of upgrading a first printer, comprising receiving across a network an external upgrade command from a management facility and a network location associated with second printer having a desired device configuration for the printer, and retrieving the desired device configuration from the network location of the second printer, where the management facility is resident on a third printer. As such, Applicant respectfully maintains that the second embodiment of McIntyre fails to teach or disclose all elements of claims 1-20, as amended.

Applicant also respectfully contends that the Office Action's selected elements alleged to be present do not teach or disclosed the claimed invention and, additionally, are clearly not arranged as required by the claims, since the elements were selected piecemeal by the Office Action from two different embodiments within the reference. The elements having been drawn

from two different embodiments negates any proper finding of anticipation under 35 U.S.C. § 102(e).

Applicant also notes that, at the time the invention was made, McIntyre and the present application were owned by, or subject to an obligation of assignment to, the same organization. Applicant also notes that the present application (U.S. Patent Application Serial No. 09/990,025) was filed on November 21, 2001. Because McIntyre qualifies as prior art only under 35 U.S.C. § 102(e) having either issued or published less than one year before the priority date of the Present Application and since McIntyre and the present Application were all commonly owned at the time of invention, the Applicant respectfully maintains that the McIntyre patent application cannot be used in support of a rejection under 35 U.S.C. § 103. See, 35 U.S.C. § 103(c).

Applicant respectfully contends that claims 1, 6, 8 and 15 as pending have been shown to be patentably distinct from the cited reference. As claims 2-5, 7, 9-14, and 16-20 depend from and further define claims 1, 6, 8 and 15, respectively, they are also considered to be in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e) and allowance of claims 1-20.

**CONCLUSION**

In view of the above remarks, Applicant believes that all pending claims are in condition for allowance and respectfully requests a Notice of Allowance be issued in this case. Please charge any further fees deemed necessary or credit any overpayment to Deposit Account No. 08-2025.

If the Examiner has any questions or concerns regarding this application, please contact the undersigned at (612) 312-2207.

Respectfully submitted,

Date: \_\_\_\_\_

5/9/08



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